REMARKS/ARGUMENTS

The rejections presented in the Office Action dated March 24, 2005 (hereinafter Office Action) have been considered. Claims 1-50 remain pending in the application. It is noted that the newly presented claims 48-50 are being added to address various aspects of the invention as supported by the original Specification, and are not being added in response to United States Patent & Trademark Office objections/rejections or to otherwise overcome any issue of patentability. Thus, it is respectfully submitted that the Applicant has not intended to narrow, nor has the Applicant narrowed, the scope of the newly presented or originally presented claims. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1-4, 34, and 46-47 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,112,244 to Moore et al. (hereinafter *Moore*). The Applicant respectfully traverses the rejection. To anticipate a claim the reference must teach every element of the claim, and it is respectfully submitted that *Moore* does not meet this standard.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the patent claim; i.e. every element of the claimed invention must be literally present, arranged as in the claim." MPEP 2131, quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). With regard to independent Claims 1, 34, 46, and 47, the Applicant submits that *Moore* does not teach every element of these claims.

Independent Claims 1, 34, 46, and 47 are directed to, *inter alia*, embedding into provisioning information an application identifier that corresponds to a network application available from a plurality of application servers. Associated application access parameters that include an application server address are also embedded in the provisioning information. The provisioning information is used to provision a mobile terminal so that the terminal can access the network application. *Moore* does not teach all of these features.

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Moore is directed to compression of messages communicated between application servers and mobile clients. The client contains a listing of application identifiers and associated codebooks. (col. 4, lines 57-61). The server element in *Moore* distributes the codebooks and application identifiers to the clients (col. 6, lines 60-65). The codebooks are used for compressing and decompressing messages sent between the client and an application server.

Moore does not show embedding an application server address into the information that is sent to the clients. As *Moore* makes clear in FIG. 3 and col. 5, lines 53-55, the server 310 that distributes the application identifiers 228 and codebooks 226 to the clients is the application server, i.e., the same element that provides the applications 324 via the network. *Moore* is silent as to how the clients obtain the application server address, except to say that the server communicates messages to the client "whenever a new client is added to the messaging system." (col. 6, lines 58-59). Therefore, there would be no need to provide an application server address to the terminals in *Moore*, because *Moore* assumes that the clients already have the capability to connect to the application server 310 before any data is transferred. The reference to addresses communicated between server and client in *Moore* at FIG. 4 and 5 and col. 6, lines 26-29, 42-45 are the addresses of the client, not of the application server. This is appropriate given the scope of *Moore*, because *Moore* is concerned with synchronizing codebooks sent from single server between a plurality of clients. Therefore, the server in *Moore* would use client addresses to determine which clients have which codebooks (see, e.g., col. 6, lines 3-10). *Moore* does not disclose or otherwise suggest the addresses in FIG. 4 and 5 are application server addresses used for selecting an application from a plurality of application servers.

Because *Moore* does not teach sending the application server address to the terminal, it also follows that Moore does not teach provisioning said terminal to facilitate access to the network application using the application server address. As explained above, *Moore* is silent as to how the clients are provisioned to obtain the application server address. Because *Moore* fails to teach both a) embedding an application server address into provisioning information, and b) using the address to provision a terminal, *Moore* fails to anticipate Claims 1, 34, 46, and 47. Therefore, Applicant respectfully submits that Claims 1, 34, 46, and 47 are in condition for allowance. In addition, the features recited above in

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regards to Claims 1, 34, 46, and 47 are also included in newly added Claims 48-50. Therefore, Applicant respectfully submits that *Moore* fails to anticipate Claims 48-50, and these claims are also in condition for allowance.

Dependent Claims 2-4 are dependent from independent Claim 1 and also stand rejected under 35 U.S.C. §102(b) as being anticipated by *Moore*. While Applicant does not acquiesce with the particular rejections to these dependent claims, these rejections are now moot in view of the remarks made in connection with independent Claim 1. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, Applicant respectfully submits that dependent Claims 2-4 are also in condition for allowance.

Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore*. Applicant respectfully traverses the rejection. According to MPEP §2142, to establish a *prima facie* case of obviousness under 35 U.S.C. §103:

1) there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

2) there must be a reasonable expectation of success; and

3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In regards to Claim 17, Applicant submits that *Moore*, even if modified as suggested in the Office Action, fails to teach or suggest all of the limitations of Claim 17. Claim 17 depends from independent Claim 1. As previously argued in greater detail herein, *Moore* fails to teach or suggest embedding an application server address into provisioning information and using the application server address to provision a terminal, as set forth in Claim 1. Because Claim 17 includes all of the limitations of Claim 1, *Moore* does not teach all the limitations of Claim 17, and a *prima facie* case of obviousness has not been established. Applicants thus respectfully submit that Claim 17 is in condition for allowance.

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Claims 5-8, 10-16, 18-24, 26-27, 30-33, 35-39, 41-42, and 44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore* as applied to claim 1 and further in view of U.S. Publication No. 2002/0123335 to Luna et al. (hereinafter *Luna*). Applicant traverses the rejection. Claims 5-8, 10-16, 18-24, 26-27, and 30-33 depend from independent Claim 1, and Claims 35-39, 41-42, and 44 depend from independent Claim 34. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. As argued in greater detail hereinabove, *Moore* fails to teach or suggest embedding an application server address into provisioning information and using the application server address to provision a terminal to access a network application, as set forth in Claims 1 and 34.

Luna fails to remedy the deficiencies of *Moore*. *Luna* merely describes a high-level provisioning system that uses push- and pull-proxies to send XML formatted provisioning data to terminals (see. e.g., [0018], [0022]). The only provisioning data described in *Luna* are home page addresses, user preferences, and privileges ([0003] and [0029]-[0030]). *Luna* is silent on communicating provisioning information that includes addresses of application servers, and using those application server addresses to provision terminals in order to access network applications. As a result, the combination of *Moore* and *Luna* fail to teach or suggest every claim limitation of Claims 5-8, 10-16, 18-24, 26-27, 30-33, 35-39, 41-42, and 44, and a *prima facie* case of obviousness has not been established. Applicant respectfully submits, therefore, that Claims 5-8, 10-16, 18-24, 26-27, 30-33, 35-39, 41-42, and 44 are in condition for allowance.

Claims 28-29, and 45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore* as applied to claim 1 and further in view of U.S. Publication No. 2002/0068554 to Dusse. (hereinafter *Dusse*). Applicant traverses the rejection. Claims 28-29 depend from independent Claim 1, and Claim 45 depends from independent Claim 34. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. As previously argued in greater detail herein, *Moore* fails to teach or suggest embedding an application server address into provisioning information and using the application server

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address to provision a terminal to access a network application, as set forth in Claims 1 and 34.

Dusse fails to remedy the deficiencies of *Moore*. *Dusse* is directed to a provisioning system using secure communications and authentication (see, e.g., [0010], [0033], and [0046]). *Dusse* is silent on communicating addresses of application servers using provisioning and using those addresses to provision terminals. *Dusse* only describes provisioning information as "software modules and registration information." ([0025]). As a result, the combination of *Moore* and *Dusse* fail to teach or suggest every claim limitation of Claims 28-29, and 45, and a *prima facie* case of obviousness has not been established. Applicant respectfully submits, therefore, that Claims 28-29, and 45 are in condition for allowance.

Claims 9, 25, 40, and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore* as applied to claim 1 and further in view of U.S. Publication No. 2003/0084177 to *Mulligan*. Applicant respectfully traverses the rejection.

While not acquiescing to the particular rejections to these claims, Applicant respectfully brings to the Examiner's attention that the secondary reference, *Mulligan*, is not a qualified reference under 35 U.S.C. § 103(c), which states that "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." *Mulligan* was published on May 1, 2003, which is later than the November 11, 2001 filing date of the present invention. Accordingly, *Mulligan* is not a qualified reference under 35 U.S.C. § 102(b). Therefore, for purposes of a § 103(a) rejection, it is assumed *Mulligan* is considered by the Examiner to be a valid reference under 35 U.S.C. § 102(e).

Applicant respectfully notes that both the instant application and *Mulligan* are assigned to a common assignee. Applicant makes reference to the assignee of record for *Mulligan* (recorded at reel 012868, frame 0553) and the assignee of record information for the instant application (recorded at reel 012666, frame 0264) to evidence such common

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ownership. Applicant also notes that the inventors of both *Mulligan* and the instant application were under an obligation of assignment to the common assignee at the time of the respective inventions. Applicant thus respectfully requests withdrawal of the rejection of Claims 9, 25, 40, and 43 under 35 U.S.C. § 103(a). As admitted in the Office Action, the primary reference *Moore* standing alone neither anticipates nor renders obvious Applicant's Claims 9, 25, 40, and 43. Therefore, Applicant respectfully submits that Claims 9, 25, 40, and 43 are in condition for allowance.
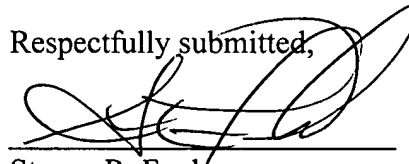
If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact him at 651-686-6633 (x110) to discuss any issues related to this case.

Respectfully submitted,

Date: 5/31/05

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